

REMARKS

By this reply, Applicants have amended claims 1, 6-10, 17, 21, 25, 30, 35, and 36. No new matter has been added by this Reply.

The art of record does not recite at least a control element configured to continue movement of the robotic element and dispensing of at least one reagent during insertion or removal of the at least one removable reagent container.

Kalra (US 5,948,359) in view of Tseung (US 2003/0099573)

Applicants respectfully traverse the 35 U.S.C. §103 rejection of claims 1-2, 6-8, 10-12, 14-16, and 36 over Kalra (US 5,948,359) in view of Tseung (US 2003/0099573). The Office Action asserts that Kalra discloses each and every feature of rejected independent claim 1, except a reagent rack removable below the plane of the robotic element during dispensing of at least one reagent. The Office relies on Tseung to disclose this feature. The cited references, however, taken alone or in combination, do not disclose all of the features of amended claim 1, including at least a control element configured to continue movement of the robotic element and dispensing of at least one reagent during insertion or removal of the at least one removable reagent container.

Kalra is silent regarding a control element configured to continue movement of the robotic element and dispensing of at least one reagent during insertion or removal of the at least one removable reagent container. Furthermore, Kalra does not suggest such a control element because the apparatus of Kalra does not permit the insertion or removal of a reagent during a staining process in which a robotic element is carrying out reagent dispensing tasks.

Kalra merely discloses a staining apparatus wherein a reagent vial holder 120 is removable from the top of the apparatus. See Kalra, FIG. 1. In Kalra, removal of a reagent vial holder 120 requires reaching, from above, through the plane on which the movable arm 30 operates. As illustrated in FIG. 1, Kalra discloses an apparatus in which a movable arm 30 is arranged above an array of slide trays 190. The slide trays 190 are disclosed to be removed from above. Due to this arrangement, it is possible for an operator to interfere with the moveable arm 30 if appropriate safety precautions are not taken. Such interference could be injurious to an operator or damaging to the apparatus. Thus, in order to prevent interference between an operator and the movable arm, Kalra discloses at col. 9, line 66 to col. 10, line 3, that "moveable arm 30 is shown in its home position, to which the arm returns when not in use. The home position is desirably selected to minimize interference with other operations, such as the insertion of microscope slides." Additionally, Kalra, at col. 17, lines 19-21 discloses "that the apparatus can process trays of slides in a manner which completes the prescribed processing on a single tray 190, and then signal the user to remove the tray and replace it with a fresh tray." Thus, Kalra discloses an apparatus that signals the user to remove a slide tray 190 and positions the moveable arm 30 in a safe "home position," during this operation.

Kalra, therefore, does not disclose or suggest "a control element configured to continue movement of the robotic element and dispensing of at least one reagent during insertion or removal of the at least one removable reagent container."

Tseung also does not disclose or suggest this feature. Tseung, at paragraph [0037] discloses an automated staining apparatus having a "reagent drawer 68" and a

"slide drawer 70" to "[facilitate] the exchange of slides 12 while limiting the impact of the exchange on the controlled environment within the processing space 18." Tseung does not disclose or suggest that the movement of a robotic element and the dispensing of reagents may continue uninterrupted when a drawer is removed. Tseung, in fact, teaches just the opposite. At paragraph [0034], Tseung discloses that "execution may be paused to add slides 12 . . . to the slide racks 20 [located in drawer 70]."

Kalra and Tseung, therefore, do not disclose or suggest all of the elements of amended claim 1, and the §103 rejection should be withdrawn. Amended independent claims 6-8, 10 and 36 recite similar features and the §103 rejection thereof should also be withdrawn. Claims 2, 11, 12, and 14-16 variously depend from independent claims 1 and 10 are therefore also not obvious in view of the cited references.

Kalra in view of Tseung and Rhett (U.S. Patent No. 5,839,091)

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 3-5 over Kalra in view of Tseung and Rhett (U.S. Patent No. 5,839,091). The Office Action cites Rhett because Rhett allegedly discloses an "optical sensor (CCD camera)." Rhett, however, does not disclose or suggest the above-discussed features of amended independent claim 1 missing from Kalra and Tseung. Therefore, the cited references, taken alone or in combination, do not disclose every element of amended independent claim 1 and no *prima facie* case of obviousness is established. Claims 3-5 depend from claim 1 and are therefore also not obvious in view of the cited references for at least the same reasons.

Kalra in view of Tseung and Ganz(WO 02/064812)

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 17-19, 21-23, 25, 27-30, and 32-34 over Kalra in view of Tseung and Ganz(WO 02/064812). The Office Action cites Ganz because Ganz allegedly discloses “a staining apparatus with a camera with a control computer.” Amended independent claims 17, 21, 25, and 30, however, recite subject matter, missing from Kalra and Tseung, similar to amended claim 1.

Ganz does not disclose or suggest the above-discussed features of amended independent claims 17, 21, 25, and 30 missing from Kalra and Tseung. Therefore, the cited references, taken alone or in combination, do not disclose every element of amended independent claims 17, 21, 25, and 30 and no prima facie case of obviousness is established. Claims 18, 19, 22, 23, 27-29, and 32-34 are variously dependent from claims 17, 21, 25, and 30 and are therefore also not obvious in view of the cited references for at least the same reasons.

Kalra in view of Tseung and Bernstein(U.S. Patent No. 5,696,887)

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 9 and 35 over Kalra in view of Tseung and Bernstein(U.S. Patent No. 5,696,887). The Office Action cites Bernstein because Bernstein allegedly discloses an “an apparatus for automated tissue assay in which samples are located in two sections which are separated by an element.” Amended independent claims 9 and 35 recite subject matter, missing from Kalra and Tseung, similar to amended claim 1.

Bernstein does not disclose or suggest the above-discussed features of amended independent claim 1 missing from Kalra and Tseung. Therefore, the cited references, taken alone or in combination, do not disclose every element of amended independent claims 9 and 35 and no *prima facie* case of obviousness is established.

In view of the foregoing remarks and amendments, Applicants submit that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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